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Docket No.: 1614.1127

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Mitsuru NAKAJIMA et al.

Serial No. 09/788,389

Group Art Unit: 2164

Confirmation No. 5409

Filed: February 21, 2001

Examiner: Dass

For: AUTHENTICATION METHOD, AUTHENTICATION SYSTEM, PAYMENT SYSTEM, USER APPARATUS AND RECORDING MEDIUM CONTAINING PROGRAM FOR CONDUCTING AUTHENTICATION

**COMMUNICATION RETURNING DEFECTIVE, MIS-DIRECTED OFFICE ACTION MAILED  
SEPTEMBER 23, 2004, RECEIVED BY UNDERSIGNED ATTORNEYS**

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Sir:

Further to a telephone message left with Examiner Dass by Bonnie Patrick, secretary to H.J. Staas of the firm of record herein, on October 5, 2004, submitted herewith is a defective Office Action mailed September 23, 2004, which clearly does not belong to the above identified application. Even though the front page of the Office Action correctly identifies the above application information and the firm of record herein, the Office Action Summary and following pages refer to a different application, under Serial No. 09/788,398 (note the reversed order of the last two numbers of the Serial Number). Moreover, e.g., there are not 19 claims in the subject application and there was no communication filed in this application on June 10, 2004 to which the Office Action mailed September 23, 2004 purports to be responding.

We, however, did receive a correct Office Action also mailed September 23, 2004 which does pertain to the above application and to which we shall respond.

Respectfully submitted,

STAAS & HALSEY LLP

Date: Oct. 20, 2004

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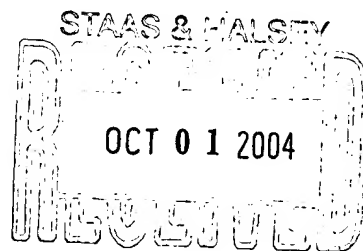
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/788,389	02/21/2001	Mitsuru Nakajima	1614.1127	5409

21171 7590 09/23/2004

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EXAMINER

DASS, HARISH T

ART UNIT PAPER NUMBER

3628

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



## Office Action Summary

Application No.

09/788,389

Applicant(s)

NAKAJIMA ET AL.

Examiner

Anh Ly

Art Unit

2172

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2004.
- 2a) ☒ This action is **FINAL**.      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. This Office Action is response to Applicants' Amendment filed on 06/10/2004.
2. Claims 17-19 have been added.
3. Claims 1-19 are pending in this Application.

### ***Response to Arguments***

4. Applicant's arguments filed 06/10/2004 have been fully considered but they are not persuasive.

Applicants argued that, "Mikurak fails to teaches each and each every feature of claim 1 to 3 and 6 to 16." And "Mikurak is not seen to discloses or suggest each and every feature of the invention." (Page 11, lines 15-16 and Page 13, lines 18-19).

5. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-3, 6-16 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,671,818 issued to Mikurak.

With respect to claim 1, Mikurak discloses a Portable Customisable data Filter and Interface (PCFI) comprising a programmable smartcard adapted to store at least a data filter parameter, and further adapted to provide a user interface by means of spatially distributed user selectable icons made visible on a surface of the smartcard (custom software interface and graphical user interface (GUI): col. 2, lines 55-67 and

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col. 9, lines 33-48; also see abstract; a smart card is programmed: col. 256, lines 15-18) and icon for user to select: col. 14, lines 61-67 and col. 78, lines 4-11 and lines 24-38);

a reader means adapted to interface with said PCFL, and further adapted to discriminate an icon on an inserted said smartcard selected by a user (smartcard reader for inserting the smartcard: col. 256, lines 25-30);

and database processing means adapted to interface with the reader means, said database processing means being (a) responsive to data filter parameter stored in said PCFI (filter parameter with customer interface is stored in the database server of the network: col. 40, lines 45-55) and detected icon selection (selectable icon: col. 78, lines 4-38 and col. 96, lines 35-60); and (b) adapted to establish the correspondingly reduced search space depend upon said filter parameter, and wherein said one or more of the database search and the data item selection is performed using the selectable icons (searching database based on the selectable icon via user interface: col. 79, lines 48-67 and col. 181, lines 5-15; also see col. 198, lines 2-67 and filter: col. 2, lines 55-67).

Mikurak discloses customizable software interface to communicate with the network. User who has a programmable smartcard would insert the smartcard to communicating with system via smartcard reader and user would see the display with a plurality of selectable icon from which the user is able to select the desired icon for searching the database stored on the network with the filter. Mikurak does not clearly teach to establish the correspondingly reduced search space dependent upon said filter parameter.

However, Mikurak teaches the searching database with some filters to get the result (col. 180, lines 48-67, col. 181, lines 5-15 and col. 198, lines 2-67).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize the graphical user interface, programmable smartcard, smartcard reader and icons for retrieving data stored in the database as taught by Mikurak because it would have made the system having a searchable database with the portable interface such as smart card with a card reader in the portable interface and the user is able to communicate directly with the network.

With respect to claim 2, Mikurak discloses wherein said data filter parameter comprises a base filter parameter, and wherein the PCFI is adapted to store another filter parameter which is combinable with said base filter parameter to thereby enable further reduction of tile dimension of the searchable database (col. 40, lines 45-55 and col. 81, lines 20-36).

With respect to claim 3, Mikurak discloses wherein said data filter parameter is a reference to said data filter parameter (col. 40, lines 45-55 and col. 181, lines 5-15).

With respect to claim 6, Mikurak discloses a programmable smartcard providing a user interface including at least one icon made visible on a surface of the smartcard, wherein the icon is capable is operable using a smartcard reader to which the smartcard is connected (a smart card is programmed: col. 256, lines 15-18) and icon for user to select: col. 14, lines 61-67 and col. 78, lines 4-11 and lines 24-38; smartcard reader for inserting the smartcard: col. 256, lines 25-30); a first data filter parameter adapted to define the reduced said search space (col. 40, lines 45-55) and a first rule adapted to

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define a second data filter parameter dependent upon the first data filter parameter (col. 2, lines 55-67 and col. 181, lines 5-15).

Mikurak discloses customizable software interface to communicate with the network. User who has a programmable smartcard would insert the smartcard to communicating with system via smartcard reader and user would see the display with a plurality of selectable icon from which the user is able to select the desired icon for searching the database stored on the network with the filter. Mikurak does not clearly teach filter parameter.

However, Mikurak teaches the searching database with some filters to get the result (col. 180, lines 48-67, col. 181, lines 5-15 and col. 198, lines 2-67).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize the graphical user interface, programmable smartcard, smartcard reader and icons for retrieving data stored in the database as taught by Mikurak because it would have made the system having a searchable database with the portable interface such as smart card with a card reader in the portable interface and the user is able to communicate directly with the network.

With respect to claims 7-9, Mikurak discloses the filter parameters (col. 40, lines 45-55 and col. 237, lines 40-67 and col. 238, lines 1-67).

With respect to claim 10, Mikurak discloses configuring a Portable Customizable data Filter and Interface (PCFI) comprising a programmable smartcard adapted to store at least a data filter parameter, and further adapted to provide a user interface by means of spatially distributed user selectable icons made visible on a surface of the



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smartcard; interconnecting the PCFI to a searchable database; selecting one or more of said user selectable icons; and performing at least one of a database search and a data item selection, dependent upon said selection (Smart card is a piece of electronic equipment, which is programmed and produced portable programmed data carriers such as credit cards (personalization data): col. 256, lines 15-18; and icon for user to select: col. 14, lines 61-67 and col. 78, lines 4-11 and lines 24-38; smartcard reader for inserting the smartcard: col. 256, lines 25-30, also a graphical user interface for monitoring peripheral devices from which the user would select the options as depicting as graphical representation on the screen: col. 9, lines 32-48, col. 16, lines 37-67 and col. 237, lines 40-67 and col. 238, lines 1-67; also see abstract); filter parameter; col. 40, lines 45-55 and col. 181, lines 5-15).

Mikurak discloses customizable software interface to communicate with the network. User who has a programmable smartcard would insert the smartcard to communicating with system via smartcard reader and user would see the display with a plurality of selectable icon from which the user is able to select the desired icon for searching the database stored on the network with the filter. Mikurak does not clearly teach to establish the correspondingly reduced search space dependent upon said filter parameter.

However, Mikurak teaches the searching database with some filters to get the result (col. 180, lines 48-67, col. 181, lines 5-15 and col. 198, lines 2-67).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize the graphical user interface, programmable smartcard,

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smartcard reader and icons for retrieving data stored in the database as taught by Mikurak because it would have made the system having a searchable database with the portable interface such as smart card with a card reader in the portable interface and the user is able to communicate directly with the network.

With respect to claims 11-12, Mikurak discloses reading the filter parameter, being a base filter parameter, from the PCFI; and applying the base filter parameter to the searchable database thereby to define the reduced search space; and wherein the step of performing one or more of a database search and a data item selection is followed, if further search space reduction is desired, by further steps of reading another filter parameter from the PCFI; combining said other filter parameter with said base filter parameter; and applying the combined filter parameters to the reduced search space thereby to define a further reduced search space and whereby said data filter parameter is a reference to said data filter parameter (col. 40, lines 45-55, col. 181, lines 5-15, col. 227, lines 42-60 and col. 229, lines 5-67; also see col. 237, lines 40-67 and col. 238, lines 1-67).

Claim 13 is essentially the same as claim 1 except that it is directed to a computer readable medium rather than a system, and is rejected for the same reason as applied to the claim 1 hereinabove.

Claim 14 is essentially the same as claim 3 except that it is directed to a computer readable medium rather than a system, and is rejected for the same reason as applied to the claim 3 hereinabove.

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With respect to claim 15, Mikurak a programmable smartcard that is operable using a smartcard reader to which the smartcard is connected; and a base data filter parameter stored in a memory of the smartcard wherein when the PFI is coupled to a database using the reader the search space of the database is reduced to a reduced search space according to the base data filter parameter (a smart card is programmed: col. 256, lines 15-18) and icon for user to select: col. 14, lines 61-67 and col. 78, lines 4-11 and lines 24-38; smartcard reader for inserting the smartcard: col. 256, lines 25-30); a first data filter parameter and a first rule adapted to define a second data filter parameter dependent upon the first data filter parameter (col. 2, lines 55-67 and col. 181, lines 5-15).

Mikurak discloses customizable software interface to communicate with the network. User who has a programmable smartcard would insert the smartcard to communicating with system via smartcard reader and user would see the display with a plurality of selectable icon from which the user is able to select the desired icon for searching the database stored on the network with the filter. Mikurak does not clearly teach the search space of the database is reduced search space according to the base data filter parameter.

However, Mikurak teaches the searching database with some filters to get the result (col. 180, lines 48-67, col. 181, lines 5-15 and col. 198, lines 2-67).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize the graphical user interface, programmable smartcard, smartcard reader and icons for retrieving data stored in the database as taught by

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Mikurak because it would have made the system having a searchable database with the portable interface such as smart card with a card reader in the portable interface and the user is able to communicate directly with the network.

With respect to claim 16, Mikurak discloses a user interface including an icon made visible on a surface of the smartcard, wherein the icon is operable using the smartcard reader, and a second data filter parameter associated with the icon and stored in the memory, wherein selection of the icon associated with the second data filter parameter causes the reduced search space established by the base data filter parameter to be further reduced in accordance with to the second data filter parameter ( graphical user interface: col. 9, lines 32-48 and col. 229, lines 5-67 and col. 230, lines 1-58; also see abstract; and col. 14, lines 61-67 and col. 78, lines 4-38; data filter parameters: col. 237, lines 40-67 and col. 238, lines 1-67).

With respect to claim 17, Mikurak teaches wherein said programmable smartcard of said PCUI stores a data filter (a smartcard is a programmable storage device: col. 256, lines 15-25), and said programming step programs said programmable smartcard of said PCFI on the basis of the data filter (filtering information of the content displayed: col. 227, 53-60);

With respect to claim 18, Mikurak teaches steps displaying customisation interface display on a screen of the customizing system on the basis of data filter stored in the PCFI (customer interface and GUI: col. 2, lines 55-67, col. 3, lines 1-5; abstract); and modifying the customisation interface display by the user selection, wherein when the predetermined icon displayed in the customization interface display is instructed by

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the user, said programming step is performed (display device is used to display the information via user interface: col. 9, lines 40-45, and the user allows to modify the items that are selected: col. 96, lines 65-67)

With respect to claim 19, Mikurak teaches wherein the customization interface display includes map information, and the database search space is reduced on the basis of the map information (searching database based on the selectable icon via interface: col. 79, lines 48-67 and col. 181, lines 5-15, database server for searching information such as map information based on the a collection of stored web page: col. 139, lines 10-12 and lines 25-32; airport map information: col. 227, 20-25).

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 4-5 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 6,671,818 issued to Mikurak.

With respect to claim 4, Mikurak discloses interfacing a customizing system to the PCFI and the PCUI using respective said smartcard readers (col. 256, lines 25-30); and programming the PCFI by means of user instructions being input to the customizing system using the user interface of the PCUI (custom software interface and graphical user interface: col. 2, lines 55-67 and col. 3, lines 1-5; also see abstract and col. 229, lines 5-67 and col. 230, lines 1-58).

With respect to claim 5, Mikurak discloses interfacing a customizing system to the PCFI using said smartcard reader (col. 256, lines 25-30); and programming the PCFI by means of user instructions being input to the customizing system using the user interface of the PCUI (custom software interface and graphical user interface: col.

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2, lines 55-67 and col. 3, lines 1-5; also see abstract and col. 229, lines 5-67 and col. 230, lines 1-58).

### ***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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**Contact Information**

12. Any inquiry concerning this communication should be directed to Anh Ly whose telephone number is (703) 306-4527 via E-Mail: **ANH.LY@USPTO.GOV**. The examiner can be reached on Monday - Friday from 8:00 AM to 4:00 PM.

If attempts to reach the examiner are unsuccessful, see the examiner's supervisor, Jonh Breene, can be reached on (703) 305-9790.

Any response to this action should be mailed to:


Commissioner of Patents and Trademarks


Washington, D.C. 20231

or faxed to: (CENTRAL FAX CENTER 703) 872-9306

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Fourth Floor (receptionist).

Inquiries of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

  
JEAN M. CORRIELLUS  
PRIMARY EXAMINER

ANH LY   
SEP. 24<sup>th</sup>, 2004



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# SEARCH REQUEST FORM

Scientific and Technical Information Center

78

Requester's Full Name: Anh Ly 4577 Examiner #: 77831 Date: 09/16/04  
Art Unit: 2172 Phone Number 306-4527 Serial Number: 09/188,398  
Mail Box and Bldg/Room Location: 4A30 Results Format Preferred (circle): PAPER DISK E-MAIL

If more than one search is submitted, please prioritize searches in order of need.

\*\*\*\*\*

Please provide a detailed statement of the search topic, and describe as specifically as possible the subject matter to be searched. Include the elected species or structures, keywords, synonyms, acronyms, and registry numbers, and combine with the concept or utility of the invention. Define any terms that may have a special meaning. Give examples or relevant citations, authors, etc, if known. Please attach a copy of the cover sheet, pertinent claims, and abstract.

Title of Invention: Customisable Filter interface  
Inventors (please provide full names): ZHENYA ALEXANDER YANKU  
Cathryn Anne Chmley & Andrew Timothy Robert Newman  
Earliest Priority Filing Date: 2/21/01

\*For Sequence Searches Only\* Please include all pertinent information (parent, child, divisional, or issued patent numbers) along with the appropriate serial number.

- \* ~~DATA~~ Visible Icon on the Surface of the Smartcard, wherein the Icon is operable using a Smart Reader to which the Smartcard is connected (#5#9) and
- \* data filter parameter stored in PCFI being adapted to reduce a database search space (#1, #5#10)

STAFF USE ONLY		Type of Search	Vendors and cost where applicable
Searcher: <u>Anne Herderson</u>	NA Sequence (#)	STN	
Searcher Phone #: <u>308-7831</u>	AA Sequence (#)	Dialog	<input checked="" type="checkbox"/>
Searcher Location:	Structure (#)	Questel/Orbit	
Date Searcher Picked Up: <u>9/20/04</u>	Bibliographic	Dr.Link	
Date Completed: <u>9/21/04</u>	Litigation	Lexis/Nexis	
Searcher Prep & Review Time: <u>30</u>	Fulltext	Sequence Systems	
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Online Time: <u>237</u>	Other	Other (specify)	



**NOTICE OF OFFICE PLAN TO CEASE SUPPLYING COPIES OF CITED U.S. PATENT  
REFERENCES WITH OFFICE ACTIONS, AND PILOT TO EVALUATE THE  
ALTERNATIVE OF PROVIDING ELECTRONIC ACCESS TO SUCH U.S. PATENT  
REFERENCES**

**Summary**

The United States Patent and Trademark Office (Office or USPTO) plans in the near future to: (1) cease mailing copies of U.S. patents and U.S. patent application publications (US patent references) with Office actions except for citations made during the international stage of an international application under the Patent Cooperation Treaty and those made during reexamination proceedings; and (2) provide electronic access to, with convenient downloading capability of, the US patent references cited in an Office action via the Office's private Patent Application Information Retrieval (PAIR) system which has a new feature called "E-Patent Reference." Before ceasing to provide copies of U.S. patent references with Office actions, the Office shall test the feasibility of the E-Patent Reference feature by conducting a two-month pilot project starting with Office actions mailed after December 1, 2003. The Office shall evaluate the pilot project and publish the results in a notice which will be posted on the Office's web site ([www.USPTO.gov](http://www.USPTO.gov)) and in the Patent Official Gazette (O.G.). In order to use the new E-Patent Reference feature during the pilot period, or when the Office ceases to send copies of U.S. patent references with Office actions, the applicant must: (1) obtain a digital certificate from the Office; (2) obtain a customer number from the Office, and (3) properly associate applications with the customer number. The pilot project does not involve or affect the current Office practice of supplying paper copies of foreign patent documents and non-patent literature with Office actions. Paper copies of references will continue to be provided by the USPTO for searches and written opinions prepared by the USPTO for international applications during the international stage and for reexamination proceedings.

**Description of Pilot Project to Provide Electronic Access to Cited U.S. Patent References**

On December 1, 2003, the Office will make available a new feature, E-Patent Reference, in the Office's private PAIR system, to allow more convenient downloading of U.S. patents and U.S. patent application publications. The new feature will allow an authorized user of private PAIR to download some or all of the U.S. patents and U.S. patent application publications cited by an examiner on form PTO-892 in Office actions, as well as U.S. patents and U.S. patent application publications submitted by applicants on form PTO/SB08 (1449) as part of an IDS. The retrieval of some or all of the documents may be performed in one downloading step with the documents encoded as Adobe Portable Document format (.pdf) files, which is an improvement over the current page-by-page retrieval capability from other USPTO systems.

## **Steps to Use the New E-Patent Reference Feature During the Pilot Project and Thereafter**

Access to private PAIR is required to utilize E-Patent Reference. If you don't already have access to private PAIR, the Office urges practitioners, and applicants not represented by a practitioner, to take advantage of the transition period to obtain a no-cost USPTO Public Key Infrastructure (PKI) digital certificate, obtain a USPTO customer number, associate all of their pending and new application filings with their customer number, install no-cost software (supplied by the Office) required to access private PAIR and E-Patent Reference feature, and make appropriate arrangements for Internet access. The full instructions for obtaining a PKI digital certificate are available at the Office's Electronic Business Center (EBC) web page at: <http://www.uspto.gov/ebc/downloads.html>. Note that a notarized signature will be required to obtain a digital certificate.

To get a Customer Number, download and complete the Customer Number Request form, PTO-SB125, at: <http://www.uspto.gov/web/forms/sb0125.pdf>. The completed form can then be transmitted by facsimile to the Electronic Business Center at (703) 308-2840, or mailed to the address on the form. If you are a registered attorney or patent agent, then your registration number must be associated with your customer number. This is accomplished by adding your registration number to the Customer Number Request form. A description of associating a customer number with an application is described at the EBC web page at: [http://www.uspto.gov/ebc/registration\\_pair.html](http://www.uspto.gov/ebc/registration_pair.html).

The E-Patent Reference feature will be accessed using a new button on the private PAIR screen. Ordinarily all of the cited U.S. patent and U.S. patent application publication references will be available over the Internet using the Office's new E-Patent Reference feature. The size of the references to be downloaded will be displayed by E-Patent Reference so the download time can be estimated. Applicants and registered practitioners can select to download all of the references or any combination of cited references. Selected references will be downloaded as complete documents as Adobe Portable Document Format (.pdf) files. For a limited period of time, the USPTO will include a copy of this notice with Office actions to encourage applicants to use this new feature and, if needed, to take the steps outlined above in order to be able to utilize this new feature during the pilot and thereafter.

During the two-month pilot, the Office will evaluate the stability and capacity of the E-Patent Reference feature to reliably provide electronic access to cited U.S. patent and U.S. patent application publication references. While copies of U.S. patent and U.S. patent application publication references cited by examiners will continue to be mailed with Office actions during the pilot project, applicants are encouraged to use the private PAIR and the E-Patent Reference feature to electronically access and download cited U.S. patent and U.S. patent application publication references so the Office will be able to objectively evaluate its performance. The public is encouraged to submit comments to the Office on the usability and performance of the E-Patent Reference feature during the pilot. Further, during the pilot period registered practitioners, and applicants not represented by a practitioner, are encouraged to experiment with the feature, develop a proficiency in using the feature, and establish new internal processes for using the new access to the cited U.S. patents and U.S. patent application publications to prepare for the anticipated cessation of the current Office practice of supplying copies of such cited

references. The Office plans to continue to provide access to the E-Patent Reference feature during its evaluation of the pilot.

### Comments

Comments concerning the E-Patent Reference feature should be in writing and directed to the Electronic Business Center (EBC) at the USPTO by electronic mail at [eReference@uspto.gov](mailto:eReference@uspto.gov) or by facsimile to (703) 308-2840. Comments will be posted and made available for public inspection. To ensure that comments are considered in the evaluation of the pilot project, comments should be submitted in writing by January 15, 2004.

Comments with respect to specific applications should be sent to the Technology Centers' customer service centers. Comments concerning digital certificates, customer numbers, and associating customer numbers with applications should be sent to the Electronic Business Center (EBC) at the USPTO by facsimile at (703) 308-2840 or by e-mail at [EBC@uspto.gov](mailto:EBC@uspto.gov).

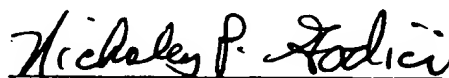
### Implementation after Pilot

After the pilot, its evaluation, and publication of a subsequent notice as indicated above, the Office expects to implement its plan to cease mailing paper copies of U.S. patent references cited during examination of non provisional applications on or after February 2, 2004; although copies of cited foreign patent documents, as well as non-patent literature, will still be mailed to the applicant until such time as substantially all applications have been scanned into IFW.

### For Further Information Contact

Technical information on the operation of the IFW system can be found on the USPTO website at <http://www.uspto.gov/web/patents/ifw/index.html>. Comments concerning the E-Patent Reference feature and questions concerning the operation of the PAIR system should be directed to the EBC at the USPTO at (866) 217-9197. The EBC may also be contacted by facsimile at (703) 308-2840 or by e-mail at [EBC@uspto.gov](mailto:EBC@uspto.gov).

Date. 12/1/03



Nicholas P. Godici  
Commissioner for Patents

# USPTO TO PROVIDE ELECTRONIC ACCESS TO CITED U.S. PATENT REFERENCES WITH OFFICE ACTIONS AND CEASE SUPPLYING PAPER COPIES

OCT 20 2004

In support of its 21<sup>st</sup> Century Strategic Plan goal of increased patent e-Government, beginning in June 2004, the United States Patent and Trademark Office (Office or USPTO) will begin the phase-in of its E-Patent Reference program and hence will: (1) **provide downloading capability of the U.S. patents and U.S. patent application publications cited in Office actions** via the E-Patent Reference feature of the Office's Patent Application Information Retrieval (PAIR) system; and (2) **cease mailing paper copies of U.S. patents and U.S. patent application publications with Office actions** (in applications and during reexamination proceedings) except for citations made during the international stage of an international application under the Patent Cooperation Treaty (PCT). In order to use the new E-Patent Reference feature applicants must: (1) obtain a digital certificate and software from the Office; (2) obtain a customer number from the Office; and (3) properly associate patent applications with the customer number. Alternatively, copies of all U.S. patents and patent application publications can be accessed without a digital certificate from the USPTO web site, from the USPTO Office of Public Records, and from commercial sources. The Office will continue the practice of supplying paper copies of foreign patent documents and non-patent literature with Office actions. Paper copies of cited references will continue to be provided by the USPTO for international applications during the international stage.

## Schedule

June 2004	TCs 1600, 1700, 2800 and 2900
July 2004	TCs 3600 and 3700
August 2004	TCs 2100 and 2600

All U.S. patents and U.S. patent application publications are available on the USPTO web site. However, a simple system for downloading the cited U.S. patents and patent application publications has been established for applicants, called the E-Patent Reference system. As E-Patent Reference and Private PAIR require participating applicants to have a customer number, retrieval software and a digital certificate, all applicants are strongly encouraged to contact the Patent Electronic Business Center to acquire these items. To be ready to use this system by June 1, 2004, contact the Patent EBC as soon as possible by phone at 866-217-9197 (toll-free), 703-305-3028 or 703-308-6845 or electronically via the Internet at [ebc@uspto.gov](mailto:ebc@uspto.gov).

## **Other Options**

The E-Patent Reference function requires the applicant to use the secure Private PAIR system, which establishes confidential communications with the applicant. Applicants using this facility must receive a digital certificate, as described above. Other options for obtaining patents which do not require the digital certificate include the USPTO's free Patents on the Web program (<http://www.uspto.gov/patft/index.html>). The USPTO's Office of Public Records also supplies copies of patents for a fee (<http://ebiz1.uspto.gov/oems25p/index.html>). Commercial sources also provide U.S. patents and patent application publications.

*For complete instructions see the Official Gazette Notice, USPTO TO PROVIDE ELECTRONIC ACCESS TO CITED U.S. PATENT REFERENCES WITH OFFICE ACTIONS AND CEASE SUPPLYING PAPER COPIES, on the USPTO web site.*